

REMARKS

[1] Claims 1-13 are pending in this application. In the Non Final Office Action dated 19 Sept 05, the Examiner rejected claims 1-10 and 12. The Examiner allowed claims 11 and 13.

[2] Claims 1-6 have been canceled. Claims 7 and 12 have been amended and these amendments are discussed below in the Traverse.

[3] Claim 7 has been amended to recite in independent form a composition comprising three fillers, which composition has at least good wear resistance at the recited pressure-velocity condition. Support for the insertion of "at least good wear resistance" is found in the specification at least at page 3, line 16; page 7, lines 6-11; page 8, lines 25-26; and at page 9, lines 14-16.

[4] Applicant has reviewed the language of claim 11 and amended it **not** for reasons related to patentability but simply to correct linguistic imprecision and to sharpen the clarity of the meaning of the claim in anticipation of its grant. As previously recited, claim 11 appeared to recite that the wear resistance of the composition was "at least 1.75 MPa-m/s (50,000 psi- fpm)". One of skill in the art would recognize that such a recitation was imprecise inasmuch as the "at least 1.75 MPa-m/s (50,000 psi- fpm)" does not indicate a measure or quality of wear resistance but a pressure-velocity condition at which wear resistance is observed.

[5] As amended herein, claim 11 recites a composition having wear resistance at the specific pressure-velocity condition "of at least 1.75 MPa-m/s (50,000 psi- fpm)". One of skill in the art would recognize that the claim now precisely recites a pressure-velocity condition at which wear resistance is observed. Support for the amendment is found at least at page 3, line 16; page 7, lines 6-7; page 8, lines 26-27; and at page 9, lines 14-16. Thus, no new matter has been introduced.

Rejections

35 U.S.C. 102(b)

[6] Claims 1-4, 12 were rejected under this provision as being anticipated by U.S. Pat. No. 5,312,866 to Tsutsumi ("Tsutsumi"). The amendments to claims 1-4 and 12 overcome this rejection and Applicant respectfully requests its withdrawal. Claim 12 has been amended to depend from Claims 7 to 10 and is therefore included in the discussion relating to the obviousness rejection.

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35 U.S.C. 103(a)

[7] Claims 5-10 were rejected under this provision as being made obvious by Tsutsumi. The amendments to claims 5-7 and 12 along with the traverse below overcome the rejection and Applicant respectfully requests its withdrawal.

Traverse

[8] At page 5, the Office Action states that

“because Tsutsumi teaches that the composition can contain at least two lubricating fillers...it would have been obvious to one of ordinary skill in the art ...to have formulated a composition of Tsutsumi which comprises a first filler..., a second filler..., a third filler ... and a fourth filler...

Thus, this rejection **relies on nothing more than a mere assertion** in the Office Action that the modification of claim 7—the addition of a third filler—and the modification of claim 9—the addition of a fourth filler—would have been obvious from Tsutsumi’s two-filler composition.

[9] MPEP 2143.03 and 2143.01 requires that a *prima facie* case of obviousness be established by:

the combination disclosing all claim elements as recited; or
the combination suggesting from within itself the modification of the present invention.
This rejection fails to establish a *prima facie* case of obviousness on both counts. Tsutsumi does not disclose two elements that are recited in claims 7 to 10, namely, “a three-filler composition” or a “four-filler composition” and “having wear resistance at the stated pressure-velocity condition”. Because of this, Tsutsumi **cannot** disclose or suggest, from within its confines, the third or fourth filler as recited in claims 7 to 10. The Examiner’s assertion that the addition of a third or fourth filler is obvious had to have arisen solely from the invention as recited in the claims.

[10] This is impermissible hindsight and creates an impermissible rejection.

[11] Since Tsutsumi does not disclose or suggest a three-filler or a four-filler composition, the Examiner’s assertion is purportedly expected to establish the evidentiary support for the rejection. The courts (*see especially In re Zurko*, 258 F.3d 1379 cited in the MPEP 2144.03 at pages 2100-136 to 137) have prohibited a mere assertion to support a *prima facie* rejection and the MPEP 2144.03(A) states:

“It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.” [emphasis added]

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The MPEP 2144.03 (B) also states that:

“The examiner must provide specific factual finding predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.”

Thus, the examiner would have had to back up with evidence the assertion that a three-filler or four-filler composition would have the recited good wear resistance at the stated pressure-velocity conditions.

[12] This the Examiner has not done. The MPEP and courts prevent examiners from reading claims and concluding, without more and without evidence, that the prior art somehow meant to encompass the claim elements. Such behavior is precisely impermissible hindsight. The MPEP 2144.08(II)(A) demands that “it is essential that Office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teachings.” The mere possibility that a claimed element could be modified “does not make the [invention] obvious ‘unless the prior art suggested the desirability of [such a] modification’ or replacement. [citation omitted]”.

[13] Even though the examiner rejected claims 1-4 on the basis of inherency, that is, that a two-filler composition disclosed in Tsutsumi must inherently have wear resistance at the stated pressure-velocity conditions, the issue in the rejection of claims 7 to 10 concerns a different composition than that disclosed in Tsutsumi. Hence, the examiner seems to extend the inherency argument applied to claims 1-4 to claims 7-10. This is improper.

[14] Tsutsumi cannot legally suggest the modification recited in claims 7 – 10, a three-filler or a four-filler composition, because the addition of the third and fourth filler has implications for creating a good to excellent wear resistance at the stated pressure-velocity condition, as disclosed in Chart 1 at page 3 of the specification. Tsutsumi does not contemplate either a three-filler or a four-filler composition nor the stated pressure-velocity condition as evidenced in the wear coefficients disclosed in Tsutsumi Tables 15 and 16.

[15] Specifically, Tsutsumi wear resistance is measured at a pressure-velocity [“PV”] condition of 0.8 MPa-m/s in Example 63. This PV condition is less than half of the recited PV condition, that is, at least 1.75 MPa-m/s and is therefore a much less severe condition. Tsutsumi’s PV value can be calculated from information in Tsutsumi, col. 28, lines 4-9, after unit conversion and multiplication. Thus, $5 \text{ Kg/cm}^2 = 0.49 \text{ MPa}$, and $100 \text{ m/min} = 1.67 \text{ m/s}$, giving $0.49 \times 1.67 = 0.8 \text{ MPa-m/s}$. This means that a skilled artisan, reading Tsutsumi’s Examples, especially 63-76, could not conclude from a disclosure relating only to a two-filler composition that a third filler or a fourth filler would substantially improve wear resistance at the recited pressure-velocity conditions.

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[16] Ultimately, Tsutsumi does not disclose all claim elements as recited in claims 7 to 10. Nor can Tsutsumi, which discloses a two-filler composition, be used, without more, to suggest the following claim elements: 1) a three-filler or a four-filler composition 2) having wear resistance at the recited pressure-velocity conditions. The rejection cannot set forth a *prima facie* case of obviousness and Applicant respectfully requests its withdrawal.

[17] Claim 12 has been amended to depend from any of Claims 7 to 10 and has been considered subject to the obviousness, not the anticipation, rejection. Because claim 12 recites either a three-filler or a four-filler composition, for the reasons stated in ¶¶ 8-15 above, the obviousness rejection could not set forth a *prima facie* case of obviousness against it. Claim 12 recites therefore a non-obviousness invention.

[18] In view of the foregoing, allowance of the above-referenced application is respectfully requested.

Respectfully submitted,



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